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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,176

03/09/2006

Graham Edmund Kelly

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

PACKARD, BENJAMIN J

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

11/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/530,176</p>	<p>Applicant(s) KELLY, GRAHAM EDMUND</p>	
	<p>Examiner Benjamin Packard</p>	<p>Art Unit 1612</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: 2.
- Claim(s) rejected: 1,3,4,8-10 and 23.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612

/Benjamin Packard/
Examiner, Art Unit 1612

Continuation of 5. Applicant's reply has overcome the following rejection(s): Claims 1-4, 6-10, 23, and 26-28 under 35 USC 112 first paragraph Written Description.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments, filed 10/09/09, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims rejection 35 USC 112 - Scope of Enablement

Claims 4 and 8-10 stand rejected under USC 112 - scope of enablement .

Applicants assert the claims are limited to the working examples.

Examiner notes claim 4 includes the prophylaxis of cancer, which is not supported by the specification given the unpredictability in treating cancer.

Claim Rejections - 35 USC § 103

Claims 1, 3-4, 8-10, and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al (WO98/008503) in view of Ekwuribe et al (US 6,380,405).

Applicant asserts the amendments limit the claimed invention to only the embodiments showing synergistic results.

Examiner disagrees. Applicant's amendments do not limit the claims to the showing of synergy demonstrated by the instant specification. Specifically, Examiner notes pg 37 Table 1 illustrates synergistic effects for cisplatin and dehydroequol for the various cancer lines tested, but the additional combinations tested in Example 2 are limited to ovarian cancer cells. Where Applicant is claiming "synergistic effect", the results are by definition unpredictable. Therefore, the additional combinations of dehydroequol and carboplatin and paclitaxel appear to be limited to only the ovarian cancer cell lines tested, i.e. CP70 and A2780.

Obvious-Type Double Patenting

Claims 1, 3-4, 8-10, and 23 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-21 of U.S. Patent No. 6,649,648 in view of Ekwuribe et al (US 6,380,405).

Applicant asserts the amendments limit the claimed invention to only the embodiments showing synergistic results.

Examiner disagrees with the showing of synergy for the reasons discussed above.

Claims 1, 3-4, 8-10, and 23 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-38 of copending Application No. 10/547,077 in view of Ekwuribe et al (US 6,380,405).

Applicant asserts because this case has the oldest filing date and no additional rejections remain, this rejection should be withdrawn.

Examiner disagrees. As discussed above, the rejections are maintained, therefore this rejection remains proper.

Allowable Subject Matter

Claim 2 stands objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, given it would not be expected that the combination of agents would cause sensitivity in cancer cells or tumor which was previous not sensitive to the anti-cancer agent, as discussed in the Office Action dated 05/12/09.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Packard whose telephone number is 571-270-3440. The examiner can normally be reached on M-F 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If

you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.